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Ditthavong & Steiner, P.C.
44 Canal Center Plaza
Suite 322
Alexandria, VA 22314

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SARBJIT SINGH SARKARIA

Appeal 2015-006527
Application 12/491,729
Technology Center 2100

Before MAHSHID D. SAADAT, SCOTT B. HOWARD, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ seeks our review under 35 U.S.C. § 134(a) from a final rejection of claims 1–18, i.e., all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the real party in interest is Nokia Corporation. App. Br. 1.

STATEMENT OF THE CASE

The Invention

The Specification describes one embodiment of the invention as “a method [that] comprises receiving a request for information regarding one or more applications installed on a user equipment in a category of applications,” where “the request includes a respective unique identifier for the one or more applications,” and “initiating transmission of the information including an icon corresponding to the one or more applications compiled using the respective unique identifier for the one or more applications.” Spec. ¶ 2.² The Specification explains that the invention permits “acquiring information regarding installed applications on a user equipment.” Abstract. The Specification also explains that the invention “could be used to provide a game viewer or browser on the user device for all games on the user device, which can be used by the user to access the games.” Spec. ¶ 29.

Exemplary Claim

Independent claim 1 exemplifies the subject matter of the claims under consideration and reads as follows:

1. A method comprising:
receiving a request for information regarding one or more applications installed on a user equipment in a category of

² This decision uses the following abbreviations: “Spec.” for the Specification, filed June 25, 2009; “Final Act.” for the Final Office Action, mailed June 19, 2014; “Adv. Act.” for the Advisory Action, mailed October 2, 2014; “App. Br.” for the Appeal Brief, filed December 22, 2014; “Ans.” for the Examiner’s Answer, mailed April 24, 2015; and “Reply Br.” for the Reply Brief, filed June 23, 2015.

applications, wherein the request includes a respective unique identifier for the one or more applications;

compiling the information corresponding to the one or more applications based on the respective unique identifier; and

initiating transmission of the information including an icon corresponding to the one or more applications compiled using the respective unique identifier for the one or more applications.

App. Br. 26 (Claims App.).

The Prior Art Supporting the Rejection on Appeal

Mehta et al. (“Mehta”)	US 2008/0301231 A1	Dec. 4, 2008
Lemay et al. (“Lemay”)	US 2009/0307105 A1	Dec. 10, 2009
De Atley et al. (“Atley”)	US 2010/0313196 A1	Dec. 9, 2010

The Rejection on Appeal

Claims 1–18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lemay, Mehta, and Atley. Final Act. 2–21; Reply Br. 2.

ANALYSIS

We have reviewed the rejection of claims 1–18 in light of Appellant’s arguments that the Examiner erred. For the reasons explained below, we are not persuaded by Appellant’s arguments.

The Rejection of Claim 1 Under 35 U.S.C. § 103(a)

THE TEACHING OR SUGGESTION
OF EVERY LIMITATION IN CLAIM 1

Appellant argues that the Examiner erred in rejecting claim 1 because the references fail to teach or suggest (1) “compiling the information corresponding to” an application based on a “unique identifier” for the application and (2) “initiating transmission of the [compiled] information including an icon corresponding to” the application. App. Br. 7–12; *see*

Reply Br. 2–3. Appellant admits, however, that “*Mehta* ‘compiles and returns a list of applications that are available and appropriate based on the subscriber, application profiles, and device profiles.’” App. Br. 10 (quoting *Mehta* ¶ 72). Appellant seeks to distinguish *Mehta* by asserting that *Mehta*’s list of applications “based on the subscriber, application profiles, and device profiles” differs from the claimed compilation of information based on a “unique identifier.” *Id.* at 10–11; *see* Reply Br. 2–3. Appellant contends that *Mehta*’s list of applications “does not have to include any information corresponding to the applications.” App. Br. 10.

For Lemay, Appellant admits that it discloses a list of game applications or “game objects” that “may include” icons. App. Br. 11. Appellant, however, argues that each game object indicates only “whether or not the user has already installed the particular game.” *Id.* (citing Lemay ¶ 110). Appellant also argues that Lemay’s “app store simply transitions to an app store interface” listing game applications “within the app store” rather than information regarding applications installed on the user equipment. Reply Br. 3. Appellant further argues that Lemay does not “include any form of unique identifier for the applications installed.” *Id.*

For Atley, Appellant admits that it discloses a unique identifier used to launch an application. App. Br. 12; *see* Reply Br. 3. Appellant, however, argues that Atley fails to disclose a unique identifier used in “a request for information regarding” an application and that “just using a unique id to launch an application is not the same as requesting information with a unique id.” App. Br. 12–13. Appellant also argues that claim 1 requires more than the mere use of a unique identifier and in particular requires the

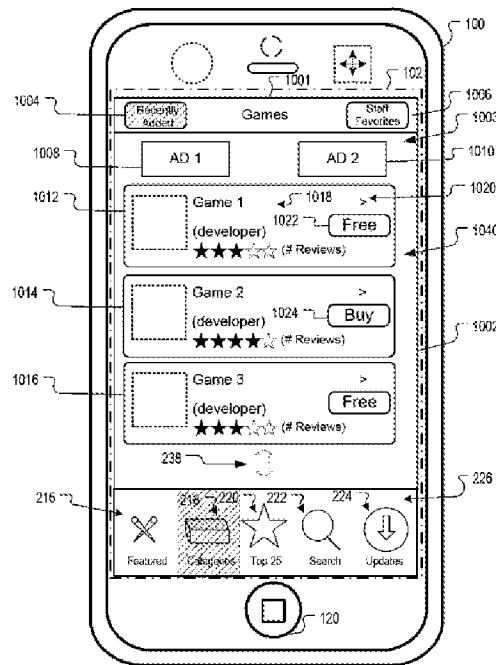
unique identifier's use for "compiling information corresponding to the applications" Reply Br. 3.

We are not persuaded by Appellant's arguments because they attack the references individually. Where a rejection rests on a combination of references, an appellant cannot establish nonobviousness by attacking the references individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the rejection rests on the combination of disclosures in Lemay, Mehta, and Atley. Final Act. 2–5, 24–25; Adv. Act. 2; Ans. 6. "[T]he test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); *see In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Appellant does not address what the Lemay-Mehta-Atley combination "taken as a whole would suggest to one of ordinary skill in the art" and, therefore, has not established Examiner error. App. Br. 7–13; Reply Br. 2–4.

The Examiner finds, and we agree, that Lemay "facilitates installing application[s] on the user equipment, which implies compiling, packaging, downloading and finally installing on the user equipment." Final Act. 3 (citing Lemay ¶¶ 100, 110, Fig. 10); *see* Adv. Act. 2. The Examiner further finds that Lemay discloses that when a user selects the app store interface icon, the "user equipment loads [the] app store application . . . onto the user equipment device." Final Act. 22. Based on Lemay Figure 10, the Examiner determines that Lemay teaches (1) a user request "for application information for a category," e.g., games; (2) a response to the user request that "is rendered onto the user equipment device"; and (3) the response to

the user request includes information about a plurality of applications within the selected category. *Id.*

Lemay Figure 10 is reproduced below:



Lemay Fig. 10. Lemay Figure 10 shows a response to a user request regarding the games category and includes a list of game applications or “game objects” with information about the respective applications, e.g., “game objects” 1012, 1014, and 1016 corresponding to games 1, 2, and 3, respectively. *Id.* ¶¶ 19, 105–110. The information about the respective applications indicates, among other things, “whether or not the user has already installed the particular game.” *Id.* ¶ 110.

The Examiner finds that Lemay Figure 10 displays a “separate icon, distinct name, and review associated with each application returned as a response to [a] search” for game applications. Final Act. 22; *see* Ans. 3. The Examiner reasons that a “skilled artisan would appreciate that without having [a] unique id for [each] application such association would not [be]

possible.” Final Act. 22–23; *see* Adv. Act. 2. Even though the Examiner finds that Figure 10 implies using a unique identifier, the Examiner cites Atley “to show explicit teaching of unique id associated with [an] application” Final Act. 23; *see* Adv. Act. 2; Ans. 8.

In addition, the Examiner finds that Mehta teaches a system and method relating to “application discovery” where a user request results in the compilation and return of a list of available applications. Final Act. 3–4 (citing Mehta ¶¶ 69, 72); *see* Adv. Act. 2; Ans. 5–6. Mehta’s list of applications must include some mechanism, such as a name or description, for distinguishing among the various available applications to permit a user to select a particular application to download. *See* Mehta ¶¶ 69, 72. Thus, Appellant’s contention that Mehta’s list of applications “does not have to include any information corresponding to the applications” does not persuade us of error. *See* App. Br. 10. Moreover, the Examiner relies on Lemay, not Mehta, as teaching the display of information corresponding to applications in response to a user request. Final Act. 22 (citing Lemay Fig. 10); *see* Ans. 3–5 (citing Lemay ¶ 110, Fig. 10).

As for Appellant’s assertion that Mehta’s list of applications “based on the subscriber, application profiles, and device profiles” differs from the claimed compilation of information based on a “unique identifier,” that assertion does not address the rejection because the Examiner relies on Atley, not Mehta, for the “unique identifier.” Final Act. 4–5, 22–23; *see* Ans. 5–6.

As for Appellant’s argument that Lemay simply lists game applications “within the app store” rather than information regarding applications installed on the user equipment, that argument disregards

Lemay's disclosure that the information displayed for a game application indicates, among other things, "whether or not the user has already installed the particular game." *See* Lemay ¶ 110, Fig. 10; *see also* Final Act. 3, 23; Ans. 3. For an installed application, a user would also see a "separate icon, distinct name, and review associated with each application" Final Act. 22 (citing Lemay Fig. 10); *see* Ans. 3.

Appellant refers to the Examiner's statement that certain features taught by Mehta and Atley are "common knowledge" to person of ordinary skill in the art. Reply Br. 3; *see* Ans. 5. Appellant then argues that "[i]f the Examiner believes this is 'common knowledge' then the Examiner should have brought the rejection with Official Notice." Reply Br. 3. We are not persuaded that the Examiner erred by citing Mehta and Atley instead of taking official notice. "In *KSR*, the Supreme Court criticized a rigid approach to determining obviousness based on the disclosures of individual prior-art references, with little recourse to the knowledge, creativity, and common sense that an ordinarily skilled artisan would have brought to bear when considering combinations or modifications." *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013) (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415–22 (2007)).

MOTIVATION TO COMBINE

Appellant argues that "[t]here is no basis for applying *De Atley*'s use of [a] unique id to combine with *Lemay* to use the unique id for information requests." App. Br. 13. But the Examiner finds, and we agree, that the motivation to combine comes from the references themselves and the goal of improving performance. Final Act. 4–5; Adv. Act. 2; Ans. 5–6. For instance, the Examiner determines that use of a unique identifier as disclosed

in Mehta would “make the system more efficient” by passing just the identifier instead of unnecessary information, thus conserving bandwidth and reducing response time. Final Act. 5; Adv. Act. 2; Ans. 6. “[T]he desire to enhance commercial opportunities by improving a product or process is universal” *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006). “[A]n implicit motivation to combine” may result from a desire to make a product or process “stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient.” *Id.*

Accordingly, the Examiner has articulated reasoning with a rational underpinning for why a person of ordinary skill in the art at the time of invention would have combined the references, including identifying advantages achieved with the combination. Final Act. 4–5; Adv. Act. 2; Ans. 5–6. Appellant does not address the Examiner’s findings regarding motivation to combine. Reply Br. 2–4.

SUMMARY FOR CLAIM 1

For the reasons discussed above, Appellant’s arguments have not persuaded us that the Examiner erred in rejecting claim 1 for obviousness based on Lemay, Mehta, and Atley. Hence, we sustain the rejection.

The Rejections of Claims 2–18 Under 35 U.S.C. § 103(a)

For independent claims 4, 7, and 12, Appellant recites various limitations in the claims and then asserts that “*Lemay* in view of *Mehta* and *De Atley*, even if combined, do not make obvious all the features of independent claim 1 (Group I), and similarly recited in independent claims 4 (Group III), 7 (Group V), and 12 (Group VII).” App. Br. 13. “A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” 37 C.F.R.

§ 41.37(c)(1)(iv). For the same reasons stated for independent claim 1, we sustain the rejection of claims 4, 7, and 12.

Claims 2 and 3 depend from claim 1; claims 5 and 6 depend from claim 4; claims 8–11 depend from claim 7; and claims 13–18 depend from claim 12. App. Br. 16–20 (Claims App.). Appellant does not make any separate patentability argument for any dependent claim. App. Br. 14; Reply Br. 2–4. For the same reasons stated for their base claims, we sustain the rejections of claims 2, 3, 5, 6, 8–11, and 13–18.

DECISION

We affirm the Examiner’s decision to reject claims 1–18.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED